

**Remarks**

Claims 21-22, 24-26 and 28-40 are currently pending in the Application.

**Summary of claim amendments**

This response amends Claim 21 to recite “said gradient composition further comprised of a plurality of alternating layers of platinum and iridium oxide” instead of “said gradient composition further comprised of platinum and iridium oxide.” Support for the amendments can be found, for example, on page 18, lines 5-7 of the specification and Figure 9, which also supports the claim in the sense of 37 C.F.R. §1.83(a).

This response amends Claim 30 to correspond to amended Claim 21.

This response amends Claim 34 to recite “wherein amount of platinum with respect to iridium oxide gradually decreases along a distance from the substrate” instead of “wherein amount of platinum with respect to iridium oxide varies along a distance from the substrate.” Support for the amendments can be found, for example, on page 17, lines 22-27 of the specification.

This response amends Claims 35-36 to correspond to amended Claim 21.

**Request under 35 C.F.R. §1.75**

The Examiner requests that Applicants cite the substrate and gradient composition of platinum and iridium oxide in the originally filed disclosure. As stated in Applicants’ response filed February 27, 2007, support for “said gradient composition further comprised of ... platinum and iridium oxide” as recited in Claim 21 can be found, for example, at page 16, lines 19-27 and page 17, lines 11-21.

The Examiner further states that he is unable to discern whether the surface coating comprises two additional elements (platinum and iridium oxide) on top of an existing

substrate or whether the surface coating is an iridium oxide coating on top of a platinum substrate. Applicants respectfully submit that Claim 21 clearly recites a “surface coating on said substrate” and that the “surface coating comprised of a gradient composition” wherein “said gradient composition further comprised of platinum and iridium oxide.” Why does the Examiner believe that the substrate recited in Claim 21 is part of the gradient composition when Claim 21 clearly recites that the “surface coating” is on said substrate”?

Because Claim 21’s substrate is not part of the gradient composition, Claim 21 is clear on its face and the Examiner’s request should be withdrawn.

**35 U.S.C. §112, second paragraph, rejection**

Claims 21-22, 24-26 and 28-40 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

According to the Examiner, it is unclear whether the claimed electrode comprises two or three elements.

Applicants submit that the Examiner has **not** established a *prima facie* case of claims being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants note that

“Definiteness of claim language must be analyzed, not in a vacuum, but in light of: A) The content of the particular application disclosure; B) The teachings of the prior art; and C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” See MPEP §2173.02.

Applicants submit that the Examiner has **not**, at least, analyzed the definiteness of Claims 21-22, 24-26 and 28-40 language in light of the content of the specification.

“In rejecting a claim under the second paragraph of 35 U.S.C. 112, it is incumbent on the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims.” See *Ex parte Wu*, 10 USPQ2d 2031, 2033 (B.P.A.I. 1989).

Applicants respectfully submit that Examiner has improperly alleged that it is unclear whether the platinum of the coating is a positively recited third element or just part of the substrate (p. 3, lines 8-9 of the Official Action). Applicants note that the Examiner has not fully considered, by way of an example and not of limitation, page 17 of the specification. Applicants submit that one of ordinary skill in the pertinent art, when reading Claims 21-22, 24-26 and 28-40 in light of page 17 of the specification, would have been able to ascertain whether the platinum of the coating is a positively recited third element or just part of the substrate. According to the specification, this “method creates an electrode 24 ... that has platinum metal adjacent to the base of the electrode substrate, and iridium oxide at the surface of the electrode ... the base of the electrode may be comprised of platinum gray, another metal, polymer, or ceramic” (p. 17, ll. 9-17 of the specification).

Applicants submit that one skilled in the art when reading features of Claims 21-22, 24-26 and 28-40 in light of page 17 of the specification would understand that the platinum that is part of the gradient is separate from the substrate.

Applicants submit that the Examiner has **not**, at least, analyzed the definiteness of Claims 21-22, 24-26 and 28-40 language in light of the content of the specification. Hence the Examiner has **not** established a *prima facie* case of Claims 21-22, 24-26 and 28-40 being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention and Applicants respectfully request that the 35 U.S.C. § 112, second paragraph, rejection be withdrawn.

**35 U.S.C. §102(e) rejection in view of Baker (U.S. 4,679,572)**

Claims 21, 24, 30, 34, 36-37 and 40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Baker. Applicants respectfully disagree. Applicants submit that the Examiner has not shown that Baker teaches each and every element as set forth in the rejected claims and Applicants submit that Baker does not teach each and every feature of the claims as amended. In particular:

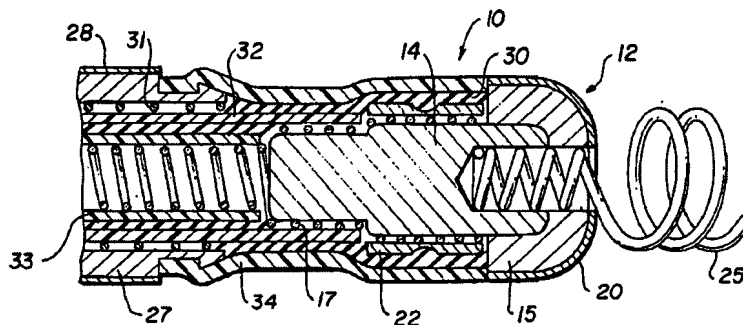
**Claim 21**

A. Applicants submit that Baker does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 21 of the present application:

**“an electrode body having a substrate surface; and a surface coating on said substrate surface, □said surface coating comprised of a gradient composition, said gradient composition further comprised of platinum and iridium oxide” (emphasis added)**

Referring to Baker's Figure 1 reproduced below, the Examiner asserts that “a substrate surface” as recited in Claim 21 is disclosed by Baker's substrate “15” (p. 4, line 2 of the Official Action). The Examiner also asserts that “a surface coating” as recited in Claim 21 is disclosed by Baker's layer “20” (p. 4, lines 2-3 of the Official Action).

**FIG. 1**



According to Baker, the platinum substrate “15” supports iridium oxide layer “20” (c. 7,

ll. 6-9 and l. 25 of Baker). Where does Baker disclose “gradient composition” comprising “**platinum** and iridium oxide” (emphasis added) as recited in Claim 21? Claim 21 clearly recites that “a surface coating “ is “on said substrate” and that the gradient composition of the surface coating comprises “platinum and iridium oxide.” Contrary to Claim 21, Baker’s substrate only supports iridium oxide layer “20.” Where does Baker’s substrate support gradient composition of the surface coating that comprises “platinum and iridium oxide” as recited in Claim 21?

Thus, because Baker does not disclose that a substrate 15 supports a gradient composition of the surface coating that comprises “platinum and iridium oxide” as recited in Claim 21, Claim 21 is patentable over Baker and should be allowed by the Examiner. Claims 24 and 30, at least based on their dependency on Claim 21, are also patentable over Baker.

**B.** Applicants submit that Baker does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 21 of the present application:

“said gradient composition further comprised of a **plurality of alternating layers of platinum and iridium oxide**” (emphasis added)

Applicants submit that Baker’s substrate 15 does not support a gradient composition wherein the gradient composition comprises “a plurality of alternating layers of platinum and iridium oxide” as recited in Claim 21. Hence, Claim 21 is patentable over Baker and should be allowed by the Examiner. Claims 24 and 30, at least based on their dependency on Claim 21, are also patentable over Baker.

#### Claim 34

**A.** Applicants submit that, at least for the reasons stated above for Claim 21, Baker does not teach, disclose or suggest “a substrate; and a surface coating, said surface coating comprising platinum and iridium oxide” as recited in Claim 34, because Baker’s coating 20 only comprises iridium oxide, **not** “platinum and iridium oxide” as recited in Claim 34. Hence, Claim 34 is patentable over Baker and should be allowed by the Examiner.

Claims 36-37, at least based on their dependency on Claim 34, are also patentable over Baker.

B. Applicants submit that Baker does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 34 of the present application:

**“wherein amount of platinum with respect to iridium oxide gradually decreases along a distance from the substrate”** (emphasis added)

Applicants submit that Baker does not disclose platinum whose amount gradually decreases along a distance from the substrate 15. Hence, Claim 34 is patentable over Baker and should be allowed by the Examiner. Claims 36-37, at least based on their dependency on Claim 34, are also patentable over Baker.

#### Claim 40

Applicants submit that Baker does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 40 of the present application:

**“sections of the electrode between the electrode base and the electrode top surface comprise platinum and iridium oxide”** (emphasis added)

Applicants submit that, although Baker discloses a platinum substrate 15 and iridium oxide layer 20, Baker does not disclose **sections** between the substrate 15 and layer 20 that comprise “platinum and iridium oxide” as recited in Claim 40. Hence, Claim 40 is patentable over Baker and should be allowed by the Examiner.

If the Examiner does not agree, the Examiner is encouraged to comply with 37 C.F.R. §1.104(c)(2) by designating “as nearly as practicable” where Baker discloses “sections ... between the electrode base and the electrode top surface comprise platinum and iridium oxide” as recited in Claim 40.

**35 U.S.C. §102(e) rejection in view of Brennen (U.S. Publ. No. 2005/0075709)**

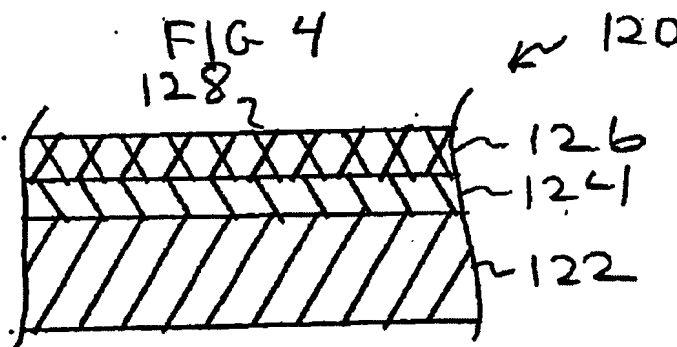
Claims 21, 24, 26, 28, 30, 33-34, 36-37 and 40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Brennen. Applicants respectfully disagree. Applicants submit that Brennen does not teach each and every feature of the claims as amended. In particular:

**Claim 21**

Applicants submit that Brennen does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 21 of the present application:

**“said gradient composition further comprised of a plurality of alternating layers of platinum and iridium oxide” (emphasis added)**

Referring to Brennen’s Figure 4 reproduced below, Brennen discloses a single platinum black layer 124 and a single iridium oxide layer 126 on top of the substrate 122.



Contrary to Brennen, amended Claim 21 recites “a plurality of alternating layers of platinum and iridium oxide.” Because Brennen does not disclose “a plurality of alternating layers of platinum and iridium oxide” as recited in Claim 21, Claim 21 is patentable over Brennen and should be allowed by the Examiner. Claims 24, 26, 28, 30 and 33, at least based on their dependency on Claim 21, are also patentable over Baker.

If the Examiner does not agree, the Examiner is encouraged to comply with 37 C.F.R. §1.104(c)(2) by designating “as nearly as practicable” where Brennen discloses “a plurality of alternating layers of platinum and iridium oxide” as recited in Claim 21.

Claim 34

Applicants submit that Brennen does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 34 of the present application:

**“wherein amount of platinum with respect to iridium oxide *gradually decreases along a distance from the substrate*” (emphasis added)**

Applicants submit that an amount of Brennen’s platinum black layer 124 does not gradually decrease along a distance from the substrate 122. Hence, Claim 34 is patentable over Brennen and should be allowed by the Examiner. Claims 36-37, at least based on their dependency on Claim 34, are also patentable over Brennen.

If the Examiner does not agree, the Examiner is encouraged to comply with 37 C.F.R. §1.104(c)(2) by designating “as nearly as practicable” where Brennen discloses that an amount of Brennen’s platinum black layer 124 gradually decreases along a distance from the substrate 122.

Claim 40

Applicants submit that Brennen does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 40 of the present application:

**“sections of the electrode *between the electrode base and the electrode top surface comprise platinum and iridium oxide*” (emphasis added)**

Applicants submit that, contrary to Claim 40, Brennen only discloses a platinum black layer 124 between the iridium oxide layer 126 and substrate 122, not **sections** that comprise “platinum and iridium oxide” as recited in Claim 40. Hence, Claim 40 is patentable over Brennen and should be allowed by the Examiner.



If the Examiner does not agree, the Examiner is encouraged to comply with 37 C.F.R. §1.104(c)(2) by designating “as nearly as practicable” where Brennen discloses “sections ... between the electrode base and the electrode top surface comprise platinum and iridium oxide” as recited in Claim 40.

**35 U.S.C. §102(e) rejection in view of Chow (U.S. 6,389,317)**

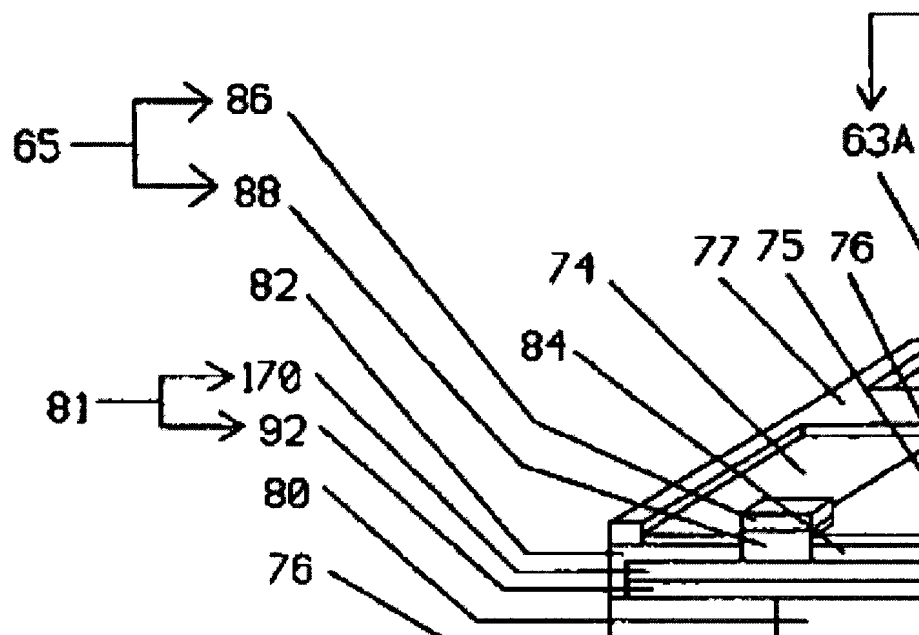
Claims 21, 30-31, 33-34, 36-37 and 39-40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Chow. Applicants respectfully disagree. Applicants submit that Baker does not teach each and every feature of the claims as amended. In particular:

**Claim 21**

Applicants submit that Chow does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 21 of the present application:

**“said gradient composition further comprised of a plurality of alternating layers of platinum and iridium oxide”** (emphasis added)

Referring to Chow’s Figure 4 partially reproduced below, Chow discloses a single platinum layer 88 and a single iridium oxide layer 86 on top of the layer 170.



Contrary to Chow, amended Claim 21 recites “a plurality of alternating layers of platinum and iridium oxide.” Because Chow does not disclose “a plurality of alternating layers of platinum and iridium oxide” as recited in Claim 21, Claim 21 is patentable over Chow and should be allowed by the Examiner. Claims 30-31 and 33, at least based on their dependency on Claim 21, are also patentable over Chow.

If the Examiner does not agree, the Examiner is encouraged to comply with 37 C.F.R. §1.104(c)(2) by designating “as nearly as practicable” where Chow discloses “a plurality of alternating layers of platinum and iridium oxide” as recited in Claim 21.

### Claim 34

Applicants submit that Chow does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 34 of the present application:

**“wherein amount of platinum with respect to iridium oxide gradually decreases along a distance from the substrate” (emphasis added)**

Applicants submit that an amount of Chow's platinum layer 88 does not gradually decreases along a distance from the layer 170. Hence, Claim 34 is patentable over Chow and should be allowed by the Examiner. Claims 36-37 and 39, at least based on their dependency on Claim 34, are also patentable over Chow.

If the Examiner does not agree, the Examiner is encouraged to comply with 37 C.F.R. §1.104(c)(2) by designating "as nearly as practicable" where Chow discloses that an amount of Chow's platinum layer 88 gradually decreases along a distance from the layer 170.

#### Claim 40

Applicants submit that Chow does not disclose, suggest or teach, *inter alia*, the following features recited by amended Claim 40 of the present application:

**"sections of the electrode between the electrode base and the electrode top surface comprise platinum and iridium oxide" (emphasis added)**

Applicants submit that, contrary to Claim 40, Chow only discloses a platinum layer 88 between the iridium oxide layer 86 and layer 177, not **sections** that comprise "platinum and iridium oxide" as recited in Claim 40. Hence, Claim 40 is patentable over Chow and should be allowed by the Examiner.

If the Examiner does not agree, the Examiner is encouraged to comply with 37 C.F.R. §1.104(c)(2) by designating "as nearly as practicable" where Chow discloses "sections ... between the electrode base and the electrode top surface comprise platinum and iridium oxide" as recited in Claim 40.

#### 35 U.S.C. §103(a) rejection

Claims 22, 29, 32 and 38 stand rejected under 35 U.S.C. §103(a) as being obvious in view of Brennen. Claim 25 stands rejected under 35 U.S.C. §103(a) as being obvious in view of Brennen or Baker.

Applicants submit that Claims 22, 25, 29, 32 and 38, at least based on their dependency on Claims 21 and 34, respectively, are believed to be patentable over Brennen or Baker, because there is no prima facie 35 USC 103(a) case based on Brennen or Baker, as shown above.

Applicants also submit that the Examiner has not established a prima facie case of obviousness for the claims rejected under 35 U.S.C. §103(a) because the Examiner has failed to show that Brennen or any other reference teach each and every element as claimed in the present application.

Applicants submit that the Examiner has not shown that Brennen discloses, suggests or teaches, *inter alia*, the following features recited by Claim 29 of the present application:

“wherein said gradient composition is an approximately **linear gradient from essentially pure platinum to essentially pure iridium oxide**”  
(emphasis added)

Although the Examiner concedes that Brennen does not disclose a linear gradient from platinum to iridium oxide, the Examiner alleges that it is well known in the art to produce approximately linear gradients between materials to improve adhesion and it would have allegedly been obvious to one skilled in the art to provide Brennen’s invention with a approximately linear gradient from platinum to iridium oxide to improve adhesion between two materials (p. 7, ll. 5-9 of the Office Action). Applicants respectfully disagree with the Examiner’s allegations.

The Examiner appears to rely on facts within his personal knowledge. Applicants respectfully request, under 37 C.F.R. § 1.104(d)(2), that the Examiner provide an Affidavit supporting the Examiner’s assertions that it is well know in the art to produce “linear gradient from essentially pure platinum to essentially pure iridium oxide” as recited in Claim 29. If the Examiner is relying on a prior art reference Applicants

respectfully request that the Examiner cite the reference. Otherwise, Applicants respectfully request that the assertion be withdrawn and Claim 29 be allowed.

Applicants finally submit that a prima facie case of obviousness has not been established because Brennen teach away from using a linear gradient.

According to MPEP §2143.01, “where the teachings of two or more prior art references conflict, the Examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991).”

According to Brennen, the platinum black layer 124 is used to enhance the adhesion of the iridium oxyde layer 126/128 to the substrate 122 (p. 2, paragraph [0030] of Brennen). Why would one skilled in the art provide linear gradient from platinum to iridium oxide to Brennen to improve adhesion as suggested by the Examiner when Brennen already discloses a way to improve adhesion by using layer 124 between substrate 122 and layer 126-128? Applicants submit that the Examiner’s combination of Brennen and some mysterious reference that discloses linear gradient is based upon a hindsight reconstruction of Applicants’ claims as opposed to what Brennen really suggest. Applicants submit that the Examiner has failed to establish a prima facie case of obviousness. The combination of the cited references is improper because they teach away from their combination. Therefore, Applicants respectfully request that the rejection be withdrawn and claims allowed.

Conclusion

In view of the above, reconsideration and allowance of all the claims are respectfully solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-0922. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 50-0922.

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(Signature)

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Respectfully submitted,



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